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In re Application of BRISCO et al	:	
U.S. Application No.: 10/551,880	:	
PCT Application No.: PCT/US2004/010317	:	
Int. Filing Date: 02 April 2004	:	
Priority Date Claimed: 02 April 2003	:	DECISION
Attorney Docket No.: 25791.270.06	:	
For: APPARATUS FOR RADIALLY EXPANDING AND PLASTICALLY DEFORMING A TUBULAR MEMBER	:	

This is in response to applicant's "Petition under 37 C.F.R. § 1.182" filed 28 August 2007.

BACKGROUND

On 02 April 2004, applicant filed international application PCT/US2004/010317, which claimed priority of an earlier United States application filed 02 April 2003. The thirty-month period for paying the basic national fee in the United States expired on 02 October 2005.

On 30 September 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification.

On 28 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of international application PCT/US2004/010317 reveals that the application contained 520 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid.
See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on 30 September 2005 did not include a proper preliminary amendment. However, it is apparent from the papers filed 30 September 2005 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 95 claims, rather than the 520 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 95 claims as opposed to 520 claims. A proper preliminary amendment was filed with the present petition, reducing the total number of claims to 95. Because of applicant's intent to reduce the number of claims for examination and because the fees due for the presence of 520 claims at the time of the initial national stage submission would not be remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

A review of the fee records for the present application reveals that \$8,350.00 has been paid for excess claim fees. The application currently contains 95 total claims, 27 of which are independent claims. Thus, a fee of \$3,750.00 for 75 claims in excess of 20 is required, and a fee of \$4,800.00 for 24 independent claims in excess of 3 is required. A total of \$200.00 will be charged to Deposit Account No. 08-1394.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision and will be forwarded to Technology Center AU 3676 for examination in due course.


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